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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,330	10/03/2000	Keizo Kimura	2016-0165P	4810

2292 7590 05/29/2002

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 05/29/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicati n N .

09/678,330

Applicant(s)

KIMURA ET AL.

Examin r

Venkataraman
Balasubramanian

Art Unit

1624

--The MAILING DATE of this communicati n appears on the cover sheet with the correspond nce address --

THE REPLY FILED 13 May 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached letter.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Letter

Applicants' response, filed 5/13/2002 under 37 CFR 1.116 in reply to the final rejection, has been considered but is not deemed to place the application in condition for allowance for the following reasons. The following rejections made in the previous office action remain.

1. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buell US 3,309,363 in view of Deguchi et al. US 5,395,742 for reasons of record.
2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crounse et al. US 3,193,548 in view of Deguchi et al. US 5,395,742 for reasons of record.

Applicants' argument to overcome this rejection is not persuasive. Following apply.

Most of the applicants' arguments were same as in paper #5 for which examiner had addressed them in paper 6. Hence they are not repeated herein. See paper # 6 for motivation, analysis of instant claims as whole, analysis of prior art as whole and prohibitive hindsight analysis. One new issues raised by the applicants are addressed herein.

However, as for applicants' urging that examiner is using hindsight based on instant disclosure, applicants' attention is drawn to the following paragraph from In re McLaughlin 170 USPQ 209 which states " Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but as long as it takes into account only the knowledge which was within the level of

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ordinary skill at the time the claimed invention was made and does not include knowledge gleaned from applicant's disclosure, such a reconstruction is proper."

In the instant case, Contrary to applicants' urging that without hindsight reasoning based on the teachings of instant application, there is no motivation for one trained in the art to combine either of the primary reference, Buell or Crounse et al. with secondary reference Deguchi et al., the combination of either of the primary reference with the secondary reference has motivation which needs no hindsight reasoning based on the teachings of the instant application.

Furthermore, as noted in paper #4 and paper # 6, there is a clear equivalency teaching of two groups in question in the primary and secondary references. Hence there is motivation for one to combine the primary and secondary references and expect to obtain desirable product for the utility taught.

Again contrary to applicants' assertion by pointing to Table on col. 5 and 6 that Buell et al. teaching is limited to two identical groups on the triazine and is critical to the utility, a careful look at the said table would show that Buell et al. indeed teaches both two identical and two different substituents and that they both have same strength of desired utility. Hence applicants' argument is misplaced.

As for applicants' argument that

Hence the above two rejections are proper and are maintained.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from

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8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

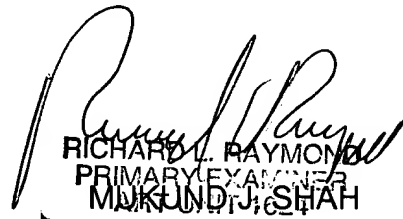
The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

VB

V. Balasubramanian

5/26/2002


RICHARD L. RAYMOND
PRIMARY EXAMINER
MUKUND J. SHAH

SUPERVISORY PATENT EXAMINER

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